

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

John PERSENDA

Conf. 5035

Application No. 10/572,938

Group 3/82

Filed May 10, 2006

Examiner Peter HELVEY

BAG HAVING AN ELASTIC BAND, AND METHOD FOR THE PRODUCTION
THEREOF

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

March 23, 2011

Applicant requests a pre-appeal brief review of the
final rejection in the above-identified application.
No amendments are being filed with this request.

A Notice of Appeal is filed concurrently herewith.

The review is requested for the reasons advanced on the
attached sheets.

Respectfully submitted,

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REASONS IN SUPPORT OF REQUEST FOR REVIEW

A pre-appeal brief review is respectfully requested of the final rejection of claims 1-10 and 14-20, claims 1, 14 and 18 being independent. The independent claims were finally rejected in the Official Action of December 23, 2010 as being unpatentable under 35 USC 103(a) over Malaspina (US Patent No. 6,585,415; "MALASPINA") in view of Midgley et al. (US Patent No. 5,120,138; "MIDGLEY").

It is respectfully submitted that the rejections of claims 1, 14 and 18 include at least a clear factual error, or in the alternative, a clear legal error, as explained below.

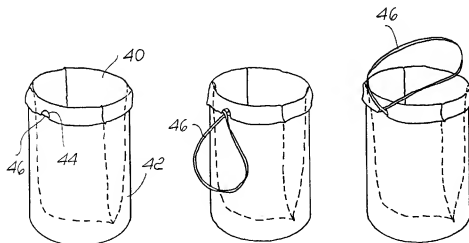
The final rejection offers MALASPINA as teaching most of the features recited, but concedes that this reference fails to teach an elastic band being further welded to the bag at an intermediate connection region, as recited by each of the independent claims 1, 14 and 18.

On page 3 of the final rejection, secondary reference MIDGLEY is offered as teaching that welding an elastic band to a bag at i) end points only, ii) continuously along the length, or iii) intermittently are all equivalents, citing column 4, lines 45-65 of this reference. The Official Action contends that at the time of the invention, it would have been obvious to a person having ordinary skill in the art to attach the elastic band taught by MALASPINA

intermittently instead of solely at the ends as taught by MIDGLEY in light of MIDGLEY teaching they were well known equivalents long before the invention was made.

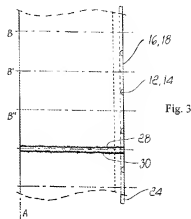
However, even if the welds taught by MIDGLEY properly suggest to one of skill the intermediate welds recited by the independent claims, one of skill would not have modified MALASPINA as suggested by the Official Action as this modification would have rendered MALASPINA unsatisfactory for its intended purpose.

In particular, MALASPINA relies on an elastic ribbon 46 long enough to twist into a loop large enough to wrap entirely around the rim of the bin 42 (see column 2 line 56 to column 3 line 19). Figures 5, 6 and 7 of MALASPINA, illustrating this mechanism, are provided below.



As can be seen by these Figures, the top edge of the bag is secured to the bin 40 not only by the length of elastic ribbon 46 outside the sheath 44, but also the length of elastic ribbon 46 within the sheath 44 looping around the

circumference of the bag to the double, closely spaced welding point 28, 30, as shown in Figure 3 (element 24 is the elastic band in this Figure; see column 2, lines 41-55).



Like an elastic waistband, the tension for securing the bag to the bin 42 comes from a tension along an entire length of the elastic ribbon 46; that is, a tension evenly applied throughout the length of elastic ribbon 46 outside the sheath 44 and the length of ribbon 46 inside the sheath 44 (e.g., elastic ribbon 24 inside sheath 16). In part, this is possible because the elastic ribbon is allowed to stretch and slide freely inside the sheath 16,18,44.

If the elastic ribbon 46 were welded at other, intermediate points within the sheath 16,18,44 as proposed by the Official Action, particularly in view of the closely spaced welds in MIDGLEY's Figure 7, tension from stretching the loop of elastic ribbon 46 around the bin 40 would pull on the welds at these intermediate points along the perimeter of the bag, causing the bag to bunch at these locations, and reducing the amount of tension on the ribbon behind the welds.

As a result, the elastic ribbon 46 would apply an uneven tension applied around the bin 42. Although the loop of elastic ribbon 46 outside the sheath 44 will act to secure the bag 40 to some degree, the length of elastic ribbon inside the sheath 44 secured by the intermediate welds of MIDGLEY would be rendered less or not effective.

Further, if the loop of the elastic ribbon 46 is pulled too hard (such as to secure around a large bin 42), the intermediate welds will tear, causing damage to the bag 40.

Hence, MIDGLEY is not properly combinable with MALASPINA. This is at least because MIDGLEY's elastics and welds are part of a sharply different mechanism from MALASPINA's elastic ribbon 46. Unlike the elastic drawstring of MALASPINA, MIDGLEY's bag is gusseted or folded with the elastics deployed at the edges of these folds (see, e.g., column 2, lines 13-27; column 3, lines 10-23 and 52-62; Figures 1-4) for allowing the bag to elastically stretch until the point that the fold is extended, and for returning the bag to a folded or bunched state when the elastic is at rest. Nothing in MIDGLEY even remotely suggests an applicable combination with MALASPINA.

Based on these reasons, it is respectfully submitted that the proposed modification of MALASPINA with MIDGLEY renders MALASPINA unsatisfactory for its intended purpose. Accordingly, it is respectfully submitted that

there would have been no reasonable motivation for one of skill to have combined these references as proposed by the Official Action.

As a consequence, it is respectfully submitted that the final rejection of the independent claims 1, 14 and 18 as obvious under 35 USC 103(a) in view of MALASPINA and MIDGLEY is improper, and that claims 1, 14 and 18 are patentable. It is also respectfully submitted that the claims depending from claims 1, 14 and 18 are patentable at least for depending from respective patentable parent claims.

Therefore, it is respectfully submitted that the obviousness rejections of record under Section 103 cannot be sustained and must be reversed; such is respectfully requested.